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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,798	01/22/2002	T. Edward Black		8658

7590 07/08/2004
T. Edward Black
1127 Miller Lane
Buffalo Grove, IL 60089

EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT PAPER NUMBER

3618

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,798

Applicant(s)

BLACK, T. EDWARD

Examiner

Frank Vanaman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/26/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Application

1. Applicant's amendment, filed April 26, 2004, has been entered in the application. Claims 2-5 are pending, claim 1 having been canceled.

Drawings- New Matter

2. The drawing amendment filed April 26, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. §132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: newly amended figure 3 now illustrates one of the connection apertures (previously labeled 'E', now labeled '15') having an orientation orthogonal to the original orientation as presented.

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification – New Matter

3. The amendment filed April 26, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. §132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment adds numerous features which were not previously disclosed: the frame being made from sheet stainless steel (page 6), the frame having been contour cut or stamped (page 6), the orthogonally oriented mounting slot 15 (page 6 – also note that the illustration of this feature constitutes the addition of new matter to the drawings as originally filed), and the provision of a plurality of openings in the top and side portions of the frame to decrease weight.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. In general, material which was not disclosed at the time of filing an application may not be added into an application at a later date.

Specification

5. The abstract of the disclosure is objected to because it includes a substantial quantity of phraseology not directed to a concise explanation of the structure of the invention (e.g., the reference to skating repertoire and to "the fertile imaginations of the members of the roller skating public"). Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: on page 4, in the description of figure 3, " shoes' " should be --shoes-- .

Appropriate correction is required.

Claim Objections

7. Claim 3 is objected to because of the following informalities: In claim 3, line 2, "shaft's" should be --shafts--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen (US 5,474,310, cited previously). Chen teaches a skate (4) including rotational locking portions (41, 42, 43) for the shafts (6) of the wheels (5) at both the longitudinal extremes of the frame, as well as intermediately thereof, including a mounting location (top of 4, figure 1) for the securing of a skating shoe thereto, and wherein the wheels are not prevented from being removed and relocated, allowing the functional limitation of a repositioning of the wheels to a different configuration.

10. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Ben-Dor et al. (US 4,273,345). Ben-Dor et al. teach a frame for in-line skates (figure 1) which allows the mounting of braking devices (31, 32) at either or both longitudinal ends thereof.

11. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by De Sarro (US 3,387,852, cited previously). DeSarro teaches a skate frame (28, 32, 27, 29) provided with a capability (32, 33) for immovably mounting a skating shoe (20) thereon

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12. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Horibata (US 5,127,672, cited previously). Horibata teaches a skate frame (2) which may accommodate a plurality of wheels (5) in plural configurations (figures 9a through 9i).

Response to Amendment

13. Applicant's comments, filed with the amendment, are noted. The examiner notes that applicant has not particularly pointed out any patentable distinction of the currently pending claims. In view of the newly presented claims, please note the newly advanced rejections, applied using the prior art cited previously in the application, in response to the new claims.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to one of the following fax servers:

Regular Communications/Amendments: 703-872-9326
After Final Amendments: 703-872-9327
Customer Service Communications: 703-872-9325

F. VANAMAN
Primary Examiner
Art Unit 3618

